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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,916

08/07/2006

Hirokazu Mihashi

MURA-102

4441

217 7590 11/24/2009

FISHER, CHRISTEN & SABOL
1120 20TH STREET, NW, SOUTH TOWER, SUITE 750
WASHINGTON, DC 20036

EXAMINER

BOMBERG, KENNETH

ART UNIT

PAPER NUMBER

3754

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,916	Applicant(s) MIHASHI ET AL.	
	Examiner KENNETH BOMBERG	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 5, 7 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2002/0153386 to Uetake et al. (Uetake) in view of US Patent No. 6,030,632 to Sawan et al. (Sawan).

In Reference to Claim 1

Uetake teaches:

A container with a filter (1) comprising:

a bottle (2) having a mouth portion (2a);

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a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle;

a filter (7,50) provided in the discharging pass;

said filter (7, 50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging ([0034]).

Uetake does not teach the following which is taught by Sawan:

and an internal liquid holding member (15) which is made of porous substance having microscopic pores that hold the liquid therein in order to keep said film wet, and which is placed on upstream side of the filtration film (col. 11, lines 27-44); and

a surface of said internal liquid holding member (15) is in contact with a surface of the filtration film (6).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the liquid holding member (pre-filter 15) of Sawan between the filter (7) and support seat (50) of Uetake in order to prevent clogging of the filter as explicitly taught by Sawan (col. 11, lines 27-49). Since the liquid holding member (pre-filter 15) of Sawan is disclosed as having a pour size within the range disclosed by applicant, it would inherently perform in the same manner.

In Reference to Claim 4

Since the holding member (pre-filter 15) of Sawan has a larger pore size than the filter (6) the pressure necessary for the internal liquid to pass through the holding member

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from the upstream side to the downstream side is lower than filtration resistance of the filtration film.

In Reference to Claim 5

See Uetake Fig. 1 and [0038]-[0041].

In Reference to Claim 7

See Uetake Fig. 1 and [0046].

4. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uetake in view of Sawan as applied to claim 1 above, and further in view of Applicants Admitted Prior Art (AAPA).

In Reference to Claim 2

Uetake as modified by Sawan teaches a container with filter substantially according to claim 1, but does not teach the particular filter according to the claim. AAPA (specification page 11, line 15 – page 12, line 6) teaches that the claimed filter is a “Millipore Express Plus membrane filter” i.e. commercially available prior art filter.

It would have been obvious to one having ordinary skill in the art to have selected the AAPA Millipore Express Plus membrane filter for use in the device of Uetake since Uetake suggests the use of any filter suited for preventing bacteria from entering the upstream side from the downstream side (see [0034]). Further the application of the AAPA filter to Uetake constitutes no more than combining prior art elements according to known methods to yield predictable results and the simple substitution of one known element for another to obtain

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predictable results supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, 82 USPQ2d 1385.

In Reference to Claim 3

When AAPA prior art filter is used with Uetake as modified by Sawan, (with the same liquid) the device would inherently perform in the same manner. Further, “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” (see MPEP 2144.05 II)

5. Claims 1, 4, 5, 7 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication No. 2002/0130139 to Shiraishi et al. (Shiraishi) in view of US Patent No. 6,030,632 to Sawan et al. (Sawan).

In Reference to Claim 1

Shiraishi teaches:

A container with a filter (1) comprising:

a bottle (2) having a mouth portion (2a);

a plug body (3) placed on the mouth portion and providing a discharging pass (10) for discharging internal liquid kept in the bottle;

a filter (7,50) provided in the discharging pass;

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said filter (7,50) has a filtration film (7) to filter out bacteria for preventing bacteria from percolating from downstream side to upstream side in the direction of discharging ([0034]).

Shiraishi does not teach the following which is taught by Sawan:

and an internal liquid holding member (15) which is made of porous substance having microscopic pores that hold the liquid therein in order to keep said film wet, and which is placed on upstream side of the filtration film (col. 11, lines 27-44); and a surface of said internal liquid holding member (15) is in contact with a surface of the filtration film (6).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the liquid holding member (pre-filter 15) of Sawan between the filter (7) and support seat (50) of Shiraishi in order to prevent clogging of the filter as explicitly taught by Sawan (col. 11, lines 27-49). Since the liquid holding member (pre-filter 15) of Sawan is disclosed as having a pore size within the range disclosed by applicant, it would inherently perform in the same manner.

In Reference to Claim 4

Since the holding member (pre-filter 15) of Sawan has a larger pore size than the filter (6) the pressure necessary for the internal liquid to pass through the holding member from the upstream side to the downstream side is lower than filtration resistance of the filtration film.

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In Reference to Claim 5

See Shiraishi Fig. 1 and [0056]-[0060].

In Reference to Claim 7

See Shiraishi Fig. 1 and [0067].

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0130139 to Shiraishi et al. (Shiraishi) and No. 6,030,632 to Sawan et al. (Sawan) as applied to claim 5 above and further in view of US Patent 5,497,910 to Meadows et al (Meadows).

In Reference to Claim 6

Shiraishi as modified by Sawan teaches:

A container with a filter (1) as set forth in claim 5 (see rejection of claim 1 above):

Shiraishi further teaches:

wherein a dispensing valve (8) has memory which expands said dispensing valve and generates negative pressure in the container so that a pressure difference between the negative pressure and an ambient pressure becomes higher than the filtration resistance thus liquid left downstream side of the filtration film is aspirated to up stream side of the filtration film (see [0043] and [0053]).

Shiraishi as modified by Sawan differs from the claim in that it is the resilient dispensing valve (8) and its associated connector sleeve (83) which causes the remaining liquid to be sucked into

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an up stream side of the of the filter rather than the memory of internal layer (22) which is disclosed to be made of a synthetic resin made of a resilient material (see [0057] and [0060]).

Meadows teaches:

In Figs. 1-3 of a dispenser similar to that of applicants' and Shiraishi to make an inner layer (inner bottle 30) from a resilient (compressible) material (LDPE) configured so as to create a "suck back" vacuum (see col. 4, lines 57-62; col. 5, lines 35-43).

It would have been obvious to one having ordinary skill in the art at the time of the invention to have applied the teaching of using the characteristics of the compressible inner bottle to suck back liquid into the inner layer of Meadows in the dispenser of Shiraishi as modified by Sawan because doing so would allow the suck back function to be performed without the use of a resilient valve.

Further the application of the teaching of Meadows to Shiraishi as modified by Sawan constitutes no more than combining prior art elements according to known methods to yield predictable results and the use of a known technique to improve similar device in the same way supporting a conclusion of obviousness in accordance with the guidance of *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. ___, 82 USPQ2d 1385.

Response to Amendment

7. Applicant's amendment to the specification has overcome the objection to the trademark usage.
8. Applicant's amendment to the drawings has overcome the objection to omitted prior art label.

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9. Applicant's amendment to claim 6 has overcome the previous rejection of claim 6 under 112, second paragraph.

Response to Arguments

10. Applicant's arguments filed July 2, 2009 have been fully considered but they are not persuasive.

In response to the Examiner's notification in paragraph 1 that the listing of references in the specification is not a proper information disclosure statement, Applicant argues that the examiner is required to read and consider all of the disclosure in the application, including the prior art disclosed and discussed in the application. The disclosure has been considered including Applicant's description of the background art; however, considering Applicant's description of a reference is not equivalent to considering the reference itself. Consequently references which were not indicated as being considered in the Notice of References Cited or the Information Disclosure Statement have not been considered

11. Applicant's arguments with respect to the prior art rejections of claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH BOMBERG whose telephone number is (571)272-4922. The examiner can normally be reached on Monday-Thursday and alternative Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571)272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Kenneth Bomberg/
Primary Examiner, Art Unit 3754